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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,894	08/29/2001	Eric D. Anderson	500247.02	2382
7590 08/13/2004			EXAMINER	
Mark W. Roberts, Esq. DORSEY & WHITNEY LLP Suite 3400 1420 Fifth Avenue Seattle, WA 98101			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	
DATE MAILED: 08/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/943,894		ANDERSON, ERIC D.	
	Examiner		Art Unit	
	David E. England		2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 - 29 and 37 - 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 - 29 and 37 - 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 11 – 29 and 37 – 44 are presented for examination.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “providing an Email communication program on a server that performs the acts of: receiving an indication of an Email communication” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “If it is determined that multiple recipients have been indicated: storing a single copy of the Email communication on the server” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “If it is determined that multiple recipients **have not** been indicated: sending the Email communication to the recipient **without waiting for a request** for the Email communication” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11, 23, 37 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of,

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“providing an Email communication program on a server that performs the acts of: receiving an indication of an Email communication,” is not found in the specification. This limitation leaves one to believe that a server will receive an Email communication, when in fact; it is a user or at least one recipient that will “receiving an indication of an Email communication” from a server.

6. Claims 11, 23, 37 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of, “If it is determined that multiple recipients have been indicated: storing a single copy of the Email communication on the server,” is not found in the specification. This limitation leaves one to interpret that an Email communication is not stored on the server until multiple recipients have been indicated. This is not supported by the specification as stated on page 9, lines 25 – 30, page 10, lines 14 – 19 and page 10, line 23 – page 11, line 7 of the Applicant’s application. In these sections, it is stated that once the server has stored the Email communication and information about the recipients, and then the server sends an indicator to at least one recipient. Furthermore, the specification states that after a recipient receives an indicator, one can store “a copy of the message in a physically distinct server location, (e.g. page 11, line 1)”, (e.g. “*in a particular folder*.” Page 10, lines 28 – 29 of Applicant’s application). Also, the application states that, “*Defaults can also affect whether various actions are available or needed (e.g. if a default behavior is to save a message unless it is explicitly deleted, a save instruction from a recipient is not necessary).*” This is stated after the section about storing in a particular folder and would

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leave one to believe that a recipient could have a copy of the original Email communication stored in a different location exclusive to that recipient. It would not seem efficient for a system to have only a single copy continually be saved and transferred to different locations in a server every time a different recipient received an indicator and cause the server to devote more resources to transferring the single copy then deem necessary.

7. Claims 11, 23, 37 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

8. The limitations of, “If it is determined that multiple recipients have been indicated: notifying each of the multiple recipients of the Email communication without sending the Email communication to the recipients,” is not found in the specification as to a condition from an indication of multiple recipients leads to another type of notification to the same multiple recipients.

9. Claims 12, 38 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10. The limitations of, “If it is determined that multiple recipients have not been indicated: sending the Email communication to the recipient **without** waiting for a request for the Email

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communication,” is not found in the specification as to a condition for not indicating multiple recipients. Furthermore, in claims 38 and 42 there is mention of “the Email communication program is further configured to perform the acts of:”, there is no mention of the Email communication program performing this condition. In fact, on page 10, lines 14 – 16 of the Applicant’s application, it states, “*In one embodiment, the Message Receiver retrieves the stored message **without the intervention of the MDS system**...*”. This would leave one to interpret that there is no “Email communication program” intervention with an Email communication.

11. Claims 18 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

12. The limitations of, “retrieving notifying instructions for a recipient by the Email communication program,” is not found in the specification. Claim 27 is rejected for similar reasons, more specifically to the act of “retrieving” the sending instructions for the recipient. The specification states that the recipient sends a “request”, (e.g. Fig. 6, 605 & Fig. 7, 705).

13. Claims 18 – 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

14. The limitations of, “notifying instructions,” is not found in the specification.

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 11, 23, 37 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. The limitations of, “If it is determined that multiple recipients have been indicated: notifying each of the multiple recipients of the Email communication without sending the Email communication to the recipients,” is misleading to if there are two different types of indicators or notifications. Furthermore, the specification makes no distinction as to an indicator or a notification.

18. Claims 18 – 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. The limitations of, “notifying instructions,” is not found in the specification as to what would designate a notifying instruction or if it could be the same as an indicator.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 11 – 13, 16 – 24, 27 – 29, 37 – 39 and 41 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848).

22. As per claim 11, as closely interpreted by the Examiner, Dillon teaches a computer-implemented method for sending an Email communication to recipients, the method comprising:

23. providing an Email communication program on a server that performs the acts of:

24. receiving an indication of an Email communication, including at least one recipient to receive the Email communication, (e.g. col. 1, line 25 – col. 2, line 38);

25. if it is determined that multiple recipients have been indicated,

a. storing a single copy of the Email communication on the server, (e.g. col. 3, lines 12 – 65);

b. notifying each of the multiple recipients of the Email to communication without sending the Email communication to the recipients, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, lines 12 – 65);

26. in response to a request for the Email communication from a recipient, sending the Email communication to the recipient, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, lines 12 – 65).

Dillon does not specifically teach determining by the Email communication program, whether multiple recipients of the Email communication have been indicated in the received indication.

27. Arnold teaches determining by the Email communication program, whether multiple recipients of the Email communication have been indicated in the received indication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it would be more efficient for a system to acknowledge when multiple recipients have been indicated so if the sender needed to know which recipient did not receive an Email the sender could resend the Email to the recipients that are missing the Email or have misplaced it.

28. As per claim 12, as closely interpreted by the Examiner, Dillon teaches if it is determined that multiple recipients have not been indicated, sending the Email communication to the recipient without waiting for a request for the Email communication, (e.g. col. 1, line 25 – col. 2, line 6).

29. As per claim 13, as closely interpreted by the Examiner, Dillon teaches the use of storing and sending Email communication but does not specifically teach tracking the sending of the Email communication to the recipients; and

30. when the Email communication has been sent to all of the recipients, deleting the stored Email communication by the Email communication program. Arnold teaches tracking the sending of a communication to the recipients, (e.g. col. 4, line 25 – col. 5, line 25); and

31. when a communication has been sent to all of the recipients, deleting the stored Email communication by the Email communication program, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine

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Arnold's limitation of deleting an attachment after all recipients have viewed it with Dillon's limitation of storing Email because it is common for systems to utilize a Email server to store Email for recipients and if a group of recipients have all viewed the Email and no longer desire the use of the stored Email on the Email server then it would be advantageous for the Email to be deleted so the Email server can have more space for other Emails that are to be sent.

32. As per claim 16, as closely interpreted by the Examiner, Dillon does not specifically teach determining a period of time for which the Email communication will be stored; and

33. when the determined period of time has expired, deleting the stored Email communication by the Email communication program. Arnold teaches determining a period of time for which the Email communication will be stored, (e.g. col. 4, line 25 – col. 5, line 25); and

34. when the determined period of time has expired, deleting the stored Email communication by the Email communication program, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because of reasons disclosed above, furthermore, if a user has information that is forgotten for a period of time, the system could delete this information, therefore freeing up space in memory.

35. As per claim 17, as closely interpreted by the Examiner, Dillon teaches wherein the notifying of a recipient of the Email communication involves sending a distinct indicator Email communication to the recipient by the Email communication program, (e.g. col. 9, line 60 – col. 10, line 40).

36. As per claim 18, as closely interpreted by the Examiner, Dillon teaches including retrieving notifying instructions for a recipient by the Email communication program, and wherein the notifying of the recipient is performed according to the notifying instructions, (e.g. col. 3, line 36 – col. 4, line 41).

37. As per claim 19, as closely interpreted by the Examiner, Dillon does not specifically teach wherein the notifying instructions are supplied by a sender of the Email communication. Arnold teaches wherein the notifying instructions are supplied by a sender of the Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because if the sender needed specific functions to be carried out with the Email communication it would be more efficient for a system to have the sender send instructions to a Email server to only allow specific recipients in a group to access the Email communication, delete the Email at a specific time, automatically send the Email to recipients at a specified time, etc.

38. As per claim 20, as closely interpreted by the Examiner, Dillon teaches wherein the notifying instructions are supplied by the recipient, (e.g. col. 3, line 36 – col. 4, line 41).

39. As per claim 21, as closely interpreted by the Examiner, Dillon does not specifically teach wherein the notifying instructions are determined automatically by the Email communication program based on past interactions with the recipient. Arnold teaches wherein

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the notifying instructions are determined automatically by the Email communication program based on past interactions with the recipient, (e.g. col. 5, line 25 – col. 6, line 49). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it is a more efficient way to have a Email communication dealt with, therefore saving time on the users side.

40. As per claim 22, as closely interpreted by the Examiner, Dillon teaches wherein the notifying instructions indicate that the notifying is to be performed in an encrypted manner, (e.g. col. 9, line 60 – col. 10, line 14).

41. Claims 23, 24, 27 – 29, 37 – 39 and 41 - 43 are rejected for similar reasons as stated above.

42. Claims 14, 15, 25, 40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) in further view of Foladare et al. (6311210) (hereinafter Foladare).

43. As per claim 14, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that none of the recipients have indicated that the Email communication is to be saved, deleting the stored Email communication by the Email communication program. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients

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and that none of the recipients have indicated that the Email communication is to be saved, deleting the stored Email communication by the Email communication program, (e.g. col. 3, lines 15 – 35). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Dillon and Arnold because if the Email communication is no longer needed, the user could have it deleted, therefore freeing up space on the system.

44. As per claim 15, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication by the Email communication program. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication by the Email communication program, (e.g. col. 3, line 55 – col. 4, line 15). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Dillon and Arnold because in case a user makes the mistake of deleting information or is unsure if the information selected for deletion is correct, the system would have to have permission to delete the information. This could be used in a form of error checking.

45. Claims 25, 40 and 44 are rejected for similar reasons as stated above.

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46. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) in further view of Landfield et al. (5632011) (hereinafter Landfield).

47. As per claim 26, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach automatically sending the Email communication to a non-recipient authorized to access the Email communication. Landfield teaches automatically sending the Email communication to a non-recipient authorized to access the Email communication, (e.g. col. 6, lines 60 – 67). It would have been obvious to one skilled in the art at the time the invention was made to combine Landfield with the combined system of Dillon and Arnold because if there is Email communication data that would have information that is dangerous to the system an non-recipient authorized to access the Email communication, (i.e. administrator), could check it for harmful information that could damage the system.

Response to Arguments

48. Applicant's arguments with respect to claims 11 – 29 and 37 – 44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De



DAVID WILEY
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